

**REMARKS**

Claims 1-4, 6, 15-22, 24-26, 28-30, 32-34, and 36-42 are pending in the present application, with claim 14 being cancelled and claims 37-42 being newly presented for examination by this amendment. Claims 1-4, 6, 14-22, 24-26, 28-30, 32-34, and 36 currently stand rejected, and claims 1, 4, 16-20, 22, 26, 30, and 34 have been amended. Reconsideration and allowance of claims 1-4, 6, 15-22, 24-26, 28-30, 32-34, and 36-42 are respectfully requested in light of the preceding amendments and following remarks.

**Examiner Interview**

Applicants thank the Examiner for her time and consideration during the telephonic interview of February 24, 2009 in connection with the present application. During the interview, the parties discussed the current rejections to the claims and the references applied therein. Applicants presented the argument that the multiple references applied by the Examiner are not combinable under § 103(a) without improper hindsight and have reiterated that argument below for the Examiner's further consideration. The parties discussed in detail the Sawabe reference and its teaching *vel non* of single reproduction paths and indicators for the same. Applicants proposed amending the claims to recite a "flag" stored in the first navigation unit, instead of an indicator, in order to overcome Sawabe as applied, which does not disclose a particular flag in its PGCs. The parties discussed paragraph [0056] of the specification as published for providing written description of this claim

term. The Examiner indicated that such an amendment would require further search and consideration, and Applicants have amended the claims in accordance with this discussion.

Claim Rejections – 35 U.S.C. § 103

Claims 1-4, 6, 14-22, 24-26, 28-30, 32-34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Pat Pub 2002/0046328 to Okada (“Okada”) in view of US Pat 5,742,569 to Yamamoto (“Yamamoto”), US Pat Pub 2001/0043790 to Saeki et al. (“Saeki”), US Pat Pub 2005/0232111 to Sawabe et al. (“Sawabe”), and Official Notice. Applicants respectfully traverse this rejection for the reasons detailed below.

With regard to claim 1, Applicants initially submit that claim 1 has been amended to recite “**a flag being stored in the first navigation data item**, the value of the flag indicating that the first navigation data item references more than one map,” and “**a flag being stored in the second navigation data item**, the value of the flag indicating that the second navigation data item references a single map.” Sawabe, which the Examiner previously applied for broadly teaching “indicators,” is silent with regard to a flag in any of its PGCs, let alone a value of the flag indicating how many reproduction paths are associated with any PGC. Thus, Sawabe does not teach the flag element in claim 1 as amended.

Further, Applicants submit that claim 1 has been amended to recite “the first navigation data item including an indicator having a value of the number

of reproduction paths associated with the first navigation data item.”

Applicants respectfully submit that this indicator has not been considered by the Examiner or identified in any of the applied references. As discussed at the interview, these amendments find support in paragraph [0056] of the specification as published, with the “flag” supported by the “S/M flag” and the “indicator” supported by the “Channel\_Ns” value discussed in example embodiments of that paragraph.

Lastly, Applicants respectfully reiterate that Okada, Saeki, Yamamoto, Sawabe, and the Examiner’s Official Notice cannot be combined either operably or without hindsight. As for the operability of the combination, the navigation information described in Okada is completely different from the navigation information described in Sawabe, Saeki, or Yamamoto. In FIG. 44 of Okada, management table 150 includes several features unique to and required for Okada’s data management scheme. Replacing the management table 150 described in Okada with the navigation information described Saeki or Yamamoto, or the inter-level navigational grouping in Sawabe, is neither suggested nor possible, because none of the features shown in management table 150 are interchangeable with the data management file shown in FIG. 9 of Saeki, the PGCI table shown in FIGS. 7A and 7B of Yamamoto, or the inter-level navigation information in FIG. 10 of Sawabe. This lack of interchangeability and function precludes a combination of these references under § 103(a). See In re Kumar, 418 F.3d 1361 (Fed. Cir. 2005) (In order to

render a claimed apparatus or method obvious, “the prior art must enable one skilled in the art to make and use” the apparatus or method); MPEP § 2141(III); KSR Int’l v. Teleflex Co., 127 S. Ct. 1728, 1733 (2007) (when looking at variations in prior art elements, a finding of non-obviousness turns on whether “the improvement is more than the predictable use of prior art elements according to their *established functions*”) (emphasis added).

As to the hindsight required in the Examiner’s reconstruction of the references, Applicants respectfully submit that the Examiner’s division of the claims is not based on interchangeable elements known in the art or a suggestion within the references, but based on which arbitrary claim pieces match with selected portions of the applied references to reconstitute the claims. For example, claim 1 recites “the first navigation data item referencing more than one map, each map for managing one of the multiple reproduction paths” and “the second data item referencing a single map for managing a single reproduction path” and separate indicators within each navigation data item indicating whether single or multiple maps are provided. The Examiner splits these elements into distinct parts, applying Yamamoto for teaching the first and second navigation data items, Saeki for teaching maps identifying reproduction paths, and Sawabe for teaching indicators of the multiplicity of reproduction paths. However, as discussed above, Sawabe does not disclose or suggest single reproduction paths (or maps thereto or indicators of the same) for a navigation data item. If a first reference does not disclose a claim element, the reference cannot teach or suggest an indicator of that claim

element, let alone teach or suggest modifying a second reference to include that indicator, except to reconstruct the claim in hindsight. Such hindsight-motivated division and matching of claim elements and references is not permissible under § 103. See KSR, 127 S. Ct. at 1733 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning”); In re Wesslau, 353 F.2d 238, 241 (C.C.P.A. 1965) (it is “impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciated of what such reference fairly suggests to one skilled in the art”).

Because Okada, alone or in combination with Saeki, Yamamoto, Sawabe, and Official Notice, fails to teach or suggest each and every element of claim 1 and notwithstanding are not combinable under § 103, these references cannot anticipate or render obvious claim 1. Claims 16-20 have been amended to recite similar features in combination as discussed above with regard to claim 1 and are thus also allowable over Okada, Yamamoto, Sawabe, Saeki, and Official Notice. Claims 2-4, 6, 14, 16, 21, 22, 24-26, 28-30, 32-34, and 36-42 are allowable at least for depending from an allowable base claim. Withdrawal of the rejection to claims 1-4, 6, 14-22, 24-26, 28-30, 32-34, and 36 under 35 U.S.C. § 103(a) is respectfully requested.

**CONCLUSION**

For the above stated reasons, reconsideration and allowance of all claims 1-4, 6, 15-22, 24-26, 28-30, 32-34, and 36-42 in the instant application are earnestly solicited. In the event that any matters remain at issue in the application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,  
HARNES, DICKEY & PIERCE, P.L.C.

By



Terry L. Clark, Reg. No. 32,644  
P.O. Box 8910  
Reston, Virginia 20195  
(703) 668-8000

QA  
TLC/REA: tlt